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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,215	10/15/2001	Luis J. Rodriguez		4475

7590 09/11/2002
LUIS J. RODRIGUEZ
60 FOURTH STREET
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EXAMINER

GARBE, STEPHEN P

ART UNIT	PAPER NUMBER
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3727

DATE MAILED: 09/11/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/978,215

Applicant(s)

RODRIGUEZ, LUIS J.

Examiner

Stephen Garbe

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 45-70 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 45-70 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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1. The substitute specification submitted on August 23, 2002, has not been entered because it contains new matter. In particular, at least all of the new subject matter beginning with "relates to a blank" on the first page of the specification is drawn to new matter.

2. The amendment filed May 20, 2002, remains objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is the incorporation by reference of application number 09/130,534. Applicant is required to cancel the new matter in the reply to this Office Action.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 45 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no original disclosure of a "mono-sectional body." All of the disclosed envelope bodies have more than one section. In addition, the phrase, "at least one," implies that there may be more than one envelope "body." However, each envelope in the original disclosure has only one "body." Therefore, the phrase, "at least one," as a modifier of "mono-sectional body" is drawn to new matter. This is a new matter rejection.

5. Claims 46-49 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. These claims are drawn to new matter for the same reason as claim 45 since they include all of its limitations. In addition, claim 49 includes new matter because of the phrase "at least one mono-sectional flap." This is a new matter rejection.

6. Claim 60 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no original disclosure of a letter sheet that is folded as required by claims 54 and 59 and is part of a continuous assembly of detachable letter sheets.

7. Claims 68-70 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no original disclosure of a letter sheet having one layer of repositionable adhesive and one layer of a dry adhesive. Every embodiment that is disclosed as having a layer of dry adhesive has only dry adhesive and no repositionable adhesive. Note, for example, the description of Figure 7F on page 13 of the original disclosure which states that the

inhibitor layer may be omitted and a dry adhesive substituted for adhesive layers 202.

This is a new matter rejection.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 45 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This claim is inaccurate, and, thus, indefinite because the limitations preceding the phrase "whereby said self sealing letter is manufactured" are not manufacturing steps.

10. Claims 46-49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims are indefinite for the same reason as claim 45 since they include all of its limitations.

11. Claim 50 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This claim is indefinite because the letter sheet is not manufactured by placing a flap in contact with a body.

12. Claims 51-53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims are indefinite for the same reason as claim 50 because they include all of its limitations.

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13. Claim 60 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This claim is indefinite because it is unclear how to make a continuous assembly of letter sheets that are folded as recited in claim 59.

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. Claims 45-47, 62-64, and 66 are rejected under 35 U.S.C. 102(b) as being anticipated by Schieman. Schieman discloses all claimed structural features including "at least one mono-sectional flap," i.e. the flap having adhesive 3 on it; "at least one mono-sectional body," i.e. the "body" having the adhesive inhibitor on it; "at least one layer of adhesive" 3; and "at least one layer of adhesive inhibitor" 4. All of the claimed function can be performed with Schieman's structure. The term "letter sheet" does not define over Schieman.

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 45-47, 49-51, 53-55, 57, 58, 62-64, 66, and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson, United States Patent No. 3,027,067 in view of either Wilbur, United States Patent No. 2,384,223 or Schieman, United States

Patent No. 2,367,440. Johnson discloses a form having all claimed features except for the claimed adhesive inhibitor. Note flaps 8, 8, and 9 which contain adhesive and are folded onto panel 4, but not sealed thereto. It would have been obvious to provide panel 4 of Johnson with adhesive inhibitor adjacent to flaps 8, 8, and 9, as taught by either Wilbur at 24 or Schieman at 4, because the inhibitor would have prevented unintentional sealing of flaps 8, 8, and 9 to the form. As modified, Johnson has a plurality of "mono-sectional flaps" 8, 8, and 9 having at least one layer of adhesive thereon and at least one "mono-sectional body" 4. "Mono-sectional body" 4 has adhesive inhibitor thereon. Regarding claim 47, it would have been obvious to use a pressure sensitive adhesive, as taught by Schieman, because it is equivalent to Johnson's adhesive and is old and well known for use with envelope flaps. Regarding claims 49, 53, 57, and 67, note Figure 7 which illustrates a detached section having all claimed features.

18. Claims 48, 52, 56, 60, and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson, United States Patent No. 3,027,067 in view of either Wilbur, United States Patent No. 2,384,223 or Schieman, United States Patent No. 2,367,440, as applied to claims 45, 50, 54, 59, and 62, respectively, and further in view of Stenner, United States Patent No. 5,607,100. It would have been obvious to produce a plurality of Johnson's forms in series, separated by lines of perforations, as taught by Stenner, because doing so is a cost effective way of mass producing the devices.

19. Claims 59 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson, United States Patent No. 3,027,067 in view of either Wilbur, United

States Patent No. 2,384,223 or Schieman, United States Patent No. 2,367,440, as applied to claim 54. It is noted that Johnson discloses four plies, i.e. a body 4 and three flaps 8, 8, 9. Each flap overlaps the body but none of the other flaps because the flaps have mitered corners. It would have been an obvious matter of choice to form flaps 8, 8, 9 without the mitered corners, thus providing a "third ply" (e.g. flap 9) which partially overlaps plies 8, 8, and 4.

20. Applicant's arguments filed on August 23, 2002, have been fully considered but they are not persuasive. Applicant's arguments are not persuasive of patentability because they focus on what the claimed invention is not, rather than on what the claimed invention is and how that differs from the prior art. In order to obtain a patent, the claims must define a structure that is different from the prior art and that is not an obvious modification of the prior art.

The primary argument that the claimed invention does not have panels is believed to be incorrect since the body of the letter sheet is a panel. Furthermore, if the body has a score line to facilitate folding, the body has at least two panels. However, this argument is irrelevant because the claims do not preclude panels and because the claims are not patentable over the prior art, as set forth in the rejections above.

21. This is an RCE of applicant's earlier Application No. 09/978,215. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL**

even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

22. Any inquiry concerning this application or proceeding should be directed to Stephen Garbe who can be reached at 703-308-1207. The examiner can normally be reached Monday-Thursday between the hours of 7:15 and 4:45 and alternate Fridays between the hours of 7:15 and 3:45.

23. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee Young, can be reached on 703-308-2572.

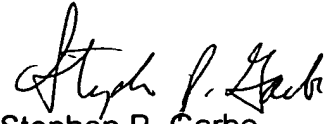
24. The fax phone numbers for Technology Center 3700 are 703-872-9302 for papers filed in response to a non-final Office Action and 703-872-9303 for papers filed in response to a Final Office Action.

25. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist, whose telephone number is 703-308-1148.

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A handwritten signature in black ink, appearing to read "Stephen P. Garbe". The signature is fluid and cursive, with the first name "Stephen" and last name "Garbe" being the most prominent parts.

Stephen P. Garbe
Primary Examiner
Group 3720